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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,990	08/22/2003	Tomoyuki Funada	14925-007001	8705
20985	7590	01/10/2005	EXAMINER	
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081				TRAN, MAI HUONG C
		ART UNIT		PAPER NUMBER
				2818

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/645,990	FUNADA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Mai-Huong Tran	2818	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 22 August 2003.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-4,6 and 13-15 is/are rejected.  
 7) Claim(s) 5,7-12 and 16-20 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 22 August 2003 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### **Drawings**

The drawings are objected to for the following reasons.

Figure 19 is not designated by a legend such as "Prior Art". The Legend is necessary in order to clarify what applicant's invention is (see MPEP § 608.02g).

Correction is required.

### **Claim Rejections - 35 U.S.C. § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6, and 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,540,412 to Yonemura et al. (hereinafter Yonemura).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the

reference was derived from the inventor of this application and is thus not the invention "by another", or by an appropriate showing under 37 CFR 1.131.

Regarding to claim 1, Yonemura discloses a semiconductor laser module comprising a stem base 23 having a top surface and bottom surface; a submount 23a provided on the top surface of the stem base 23; a laser diode 23b mounted on the submount 23a; a photodetector 23c placed, below the laser diode 23b, on the stem base 23; a first lead pin 24a for supplying a normal-phase current to the laser diode 23b, the first lead pin 24a extending through the stem base 23; and a second lead pin 24b for supplying a reverse-phase current to the laser diode, the second lead pin 24b extending through the stem base 23, wherein the submount 23a has an aperture in which the photodetector 23c is at least partially disposed (col. 8, lines 15-31, and fig. 6).

Regarding to claim 2, the semiconductor laser module wherein the aperture extends through the submount and is open where the aperture faces the stem base (fig. 6).

Regarding to claim 3, the semiconductor laser module, wherein the aperture

is a recess formed on an edge of the submount, the recess being open where the recess faces the stem base (fig. 6).

Regarding to claim 4, the semiconductor laser module, wherein the laser diode and the photodetector have a common optical axis X1 (fig. 6).

Regarding to claim 6. The semiconductor laser module, further comprising a stem block 21 provided on the top surface of the stem base 23, wherein the submount 23a is fixed on the stem block 21 (fig. 6).

Regarding to claim 13, the semiconductor laser module, further comprising a ground lead pin for grounding the stem base, wherein a depression is formed on the bottom surface of the stem base, and wherein an end of the ground lead pin is attached to the stem base in the depression (col. 3, lines 9-13).

Regarding to claim 14, the semiconductor laser module, further comprising a cap attached to the stem base, a first sleeve for optical coupling between the laser module and an external optical component, and a second sleeve for interconnection between the cap and the first sleeve, wherein the second sleeve

has a first portion placed near the cap and a second portion placed near the first sleeve, and wherein an outside diameter of the first portion is smaller than that of the second portion (col. 6, lines 21-50, fig. 2).

Regarding to claim 15, the semiconductor laser module, wherein a guide groove is formed on the submount, and wherein an optical fiber is placed in the guide groove, the guide groove having a depth at which the optical fiber is aligned with the ~~laser diode~~ to achieve optical coupling (col. 19, lines 33-67, col. 20, lines 1-15, and figs. 15A-15D).

#### **Allowable Subject Matter**

Claims 5, 7-12 and 16-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mai-Huong Tran whose telephone number is (571)272-1796. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Nelms can be reached on (571)272-1787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*MHT*

*Mai-Huong Tran*  
Mai-Huong Tran  
Examiner  
Art Unit 2818